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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,754	07/03/2001	William E. Saltzstein	PHYS116783	5287
7590	04/01/2004		EXAMINER	
Steven J. Shumaker SHUMAKER & SIEFFERT, P.A. 8425 Seasons Parkway Suite 105 St. Paul, MN 55125			EVANISKO, GEORGE ROBERT	
			ART UNIT	PAPER NUMBER
			3762	15
DATE MAILED: 04/01/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/898,754	SALTZSTEIN ET AL.
	Examiner	Art Unit
	George R Evanisko	3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 1/22/04.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-79 is/are pending in the application.

4a) Of the above claim(s) 10-14 and 21-73 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-9, 15-20 and 74-79 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 10-14 and 21-73 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 12.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3, 7, 15-17, and 74-79 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Morgan et al (5593426).

Claims 1-4, 15-18, and 74-79 are rejected under 35 U.S.C. 102(a) as being anticipated by the Applicants own admission. Figure 1 and page 2, line 12 to page 3, line 9, in applicants specification describe a prior art or conventional system that meets the limitations of the claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al. Morgan uses RF signal carriers and cellular telephone links which are a specialized mobile radio network. In addition, Morgan detects movement of a defibrillator operation parameter such as battery voltage.

In the alternative, Morgan discloses the claimed invention except for the network being a specialized mobile radio network and the status assessment being the power supply voltage level. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the defibrillator and base station communication system as taught by Morgan, with the communication system using a specialized mobile radio network and the status assessment being the power supply voltage level since it was known in the art that communication systems use specialized mobile radio networks to provide a conventional communication network that can easily and inexpensively transfer data on existing networks and since it was known that defibrillators take status assessments of the power supply voltage level to allow the operator/physician/technician to know the level of the power supply to determine if the defibrillator will operate correctly or if the power supply needs to be changed.

Claims 5, 6, 8 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al. Morgan discloses that the base communication station may include a computer or a microprocessor controlled device that can include a modem and therefore provides the control unit, interface and user interface of the base/remote station. In the alternative, see the rejection below.

Morgan discloses the claimed invention except for the communication network being a two way paging network (claims 5 and 20), a wired digital data network (claim 6), a wireless LAN (claim 18), and a digital personal communication service network (claim 19), and the remote monitoring service comprising a control unit to initiate communication, an interface to support communication, and a user interface with a display to transfer information between a user and the control unit (claim 8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the defibrillator and base station communication system as taught by Morgan, with the communication network being a two way paging network (claims 5 and 20), a wired digital data network (claim 6), a wireless LAN (claim 18), or a digital personal communication service network (claim 19), and the remote monitoring service comprising a control unit to initiate communication, an interface to support communication, and a user interface with a display to transfer information between a user and the control unit since it was known in the art that communications systems use the communication network being a two way paging network (claims 5 and 20), a wired digital data network (claim 6), a wireless LAN (claim 18), or a digital personal communication service network (claim 19) to provide a conventional communication network that can easily and inexpensively transfer data on existing networks and since it was known in the art that

base/remote stations comprise a control unit to initiate communication, an interface to support communication, and a user interface with a display to transfer information between a user and the control unit to provide an operator friendly device that is easy to operate, that allows the base station to communicate with the medical device, and that allows the operator to control the base station and examine data on the display.

In addition, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the defibrillator and base station communication system as taught by Morgan with the communication network being a two way paging network (claims 5 and 20), a wired digital data network (claim 6), a wireless LAN (claim 18), or a digital personal communication service network (claim 19), because Applicant has not disclosed that the communication network being a two way paging network (claims 5 and 20), a wired digital data network (claim 6), a wireless LAN (claim 18), or a digital personal communication service network (claim 19), provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with two way communication system using telephone, cellular or RF signal carriers as taught by Morgan, because they provide a two way communication system that uses existing networks to easily and inexpensively transfer data.

Therefore, it would have been an obvious matter of design choice to modify Morgan to obtain the invention as specified in the claim(s).

#### ***Response to Arguments***

Applicant's arguments filed 1/22/04 have been fully considered but they are not persuasive.

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The examiner is requesting, under 37 CFR 1.105, information from the applicant's agents and inventors concerning the prior art or conventional systems described in the specification on pages 2 and 3 and shown in Figure 1. The information requested is any patent or publication regarding these prior art systems or any direct knowledge of these prior art systems. In addition, the examiner is requesting information on whether these conventional systems use the remote service to initiate communication to the medical device, the communication containing instructions for the medical device to perform a status assessment when the device is not in use, and the medical device sending a communication back to the remote monitoring service, with the return communication including a status assessment of the medical device

The argument that the applicant's specification does not meet the claimed limitations is not persuasive. The specification on page 2, line 12 to page 3, line 16, describes a prior art and conventional system that meets all of the rejected claim limitations. For example, for an analysis of claim 1, the specification describes a remote monitoring service (page 2, lines 12, 14, 19, 27, 30, etc.), a two way communication network (page 2, lines 15, 16, 23, 25, 28, etc.), a medical device (page 2, lines 12, 13, 16, 18, 20, 26, 28, etc.), wherein the remote monitoring service is configured to send/initiate a communication to the medical device (page 2, lines 12, 13, 16, 17, 28, page 3, lines 1, 2, etc.), having an instruction for the medical device to perform and obtain a status assessment (page 2, lines 12, 13, 17, page 3, lines 2, 5, 6, etc.), when not in use (page 3, line 5), and send a return communication with the status assessment (page 2, lines 26, 27, 29, page 3, lines 2, 5, 6, etc.).

The argument that the examiner must provide a full and reasoned explanation of the Morgan reference is not persuasive since the examiner did provide a full and reasoned

explanation since the Morgan reference “clearly anticipates” the claimed limitations and the reference clearly shows all of the claimed limitations. In addition, the examiner provided a marked up copy of the Morgan reference showing the claimed limitations. The examiner will provide the same marked up copy with this action. For example, for an analysis of claim 1, the Morgan reference describes a remote monitoring service (col. 3, lines 35-38, etc), a two way communication network (col. 3, lines 41-44, etc.), a medical device (col. 3, lines 4-30, etc.), wherein the remote monitoring service is configured to send/initiate a communication to the medical device (col. 5, lines 24-25, etc.), having an instruction for the medical device to perform and obtain a status assessment (col. 5, lines 5-25, etc.), when not in use (col. 5, lines 9-10), and send a return communication with the status assessment (col. 5, lines 5-25, etc.).

As stated previously, Brystrom et al is one teaching of many showing the use of a paging network for communication. Duffin, Begun et al, or Rockwell et al, are teachings of the requirements of the base station. Powers et al is one teaching of many showing the state assessment of power supply voltage level. In addition, the applicants own admission on pages 2 and 3 of the specification show other conventional or prior art systems that use the well known components, used in the 103 rejections above, such as the specialized proprietary RF systems, LAN, cellular, etc.

Finally, the argument that the examiner has a burden to develop a *prima facie* case of obviousness by providing references which include each limitation of the claims for the “obvious matter of design choice” is not persuasive. According to MPEP 2144, sources of rationale supporting a rejection under 35 USC 103 may be in a reference, or reasoned from common knowledge in the art, scientific principles, art recognized equivalents, or legal precedent. The

examiner only needs to provide a reference if there is a reliance on common knowledge in the art or “well known” prior art. The examiner is not stating for the 103 rejections regarding design choice that they are due to common knowledge but stating that the specification has not provided any reasoning or criticality for the claimed elements and lacking such, the examiner does not find patentable subject matter in those limitations. The systems of the prior art operate on basically the same principle and in the same manner as the applicant’s device. Those limitations which applicant relies on provide no novel or unexpected results and use of such limitations in lieu of those used in the references solves no stated problem and would be an obvious matter of design choice within the skill in the art. (see *In re Kuhle*, 188 USPQ 7 and MPEP 2144.04)

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R Evanisko whose telephone number is 703 308-2612. The examiner can normally be reached on M-F 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703 308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

George R Evanisko  
Primary Examiner  
Art Unit 3762

7/26/4

GRE  
March 26, 2004